

56  
BL  
layer of web material at least a second layer of web material,

Q1  
- wherein the adhesive is applied in areas corresponding to at least some protuberances of said second set of protuberances, the sheet material being substantially free of adhesive in correspondence with protuberances of said first set of protuberances forming said background pattern, wherein the second set of protuberances are provided on the first layer before the first layer is joined to said second layer.

R E M A R K S

Applicant has considered the outstanding official action. It is respectfully submitted that the claims are directed to patentable subject matter as set forth below.

Claims 21-49 have been cancelled as being drawn to non-elected Groups II and III. Applicant reserves the right to pursue the subject matter of non-elected claims 21-49 in a divisional application.

Claims 1-20 have been rewritten as new claims 50-87 and new claim 88 added. New claims 50-88 correspond to the cancelled claims as follows:

<u>Prior claims</u>	<u>New claims</u>
1	50
2	51
3	52

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4	53
5	54
6	55
7	56
8/5 or 6	57
9/5 or 6	58
10	59
11	60
12	61
13/3	62
14	63
15	64
16/14	65
17/14	66
18/14, 16 or 17	67
19	68
20/14, 16 or 17	69
8/3	70
8/4	71
8/7	72
9/3	73
9/4	74
9/7	75
9/8	76
13/14	77
16/15	78

18/15	79
20/15	80
20/18	81
20/19	82
17/15	83
18/16/15	84
18/17/15	85
20/16/15	86
20/17/15	87
1 + limitation	88

The amendments to claims 1-20 to provide rewritten claims 50-87 are as to form only and are to better conform the claims to U.S. claim practice, e.g. correcting multiple dependent form, deleting reference numerals, providing proper antecedent basis, etc. No new matter has been added.

Claims 8, 9 and 20 are objected to under 37 C.F.R. §1.75(c) as being in improper multiple dependent form. Applicant has amended the claims to address this matter. Withdrawal of the objection is respectfully requested.

Claims 8, 9, 13, 16, 18 and 20 are objected to under 37 C.F.R. §1.75(c) as being in improper multiple dependent form for depending from other multiple dependent claims. Applicant has amended the claims to address this matter. Withdrawal of the objection is respectfully requested.

Claims 7 and 12 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite based on two phrases referred to by the Examiner at page 3 of the official action. Applicant has amended the claims as suggested by the Examiner. Withdrawal of the rejection is respectfully requested.

The outstanding rejections based on art are as follows:

- (1) Claims 1-3, 5-7, 10 and 14 are rejected under 35 U.S.C. §103(a) as being unpatentable over European Patent Application 0 408 248 A2 (Schulz '248) in view of U.S. Patent No. 4,320,162 (Schulz '162);
- (2) Claim 4 is rejected under 35 U.S.C. §103(a) as being unpatentable over Schulz '248 in view of Schulz '162 as applied to claim 3 above, and further in view of U.S. Patent No. 5,686,168 (Laurent '168); and
- (3) Claims 11 and 12 are rejected under 35 U.S.C. §103(a) as being unpatentable over Schulz '248 in view of Schulz '162 as applied to claim 10 above, and further in view of WO 97/44528 (Barnholtz) and U.S. Patent No. 5,736,223 (Laurent '223).

Applicant notes that claim 1 (rewritten as new claim 50) and claim 88 (which is based on prior claim 1 with an additional limitation) are the only independent claims pending. Claims 4, 11 and 12 (new claims 53, 60 and 61 respectively) are

dependent directly or indirectly on independent claim 50.  
Withdrawal of the outstanding rejections are requested.

The present invention is directed to a method for producing an embossed sheet material including at least two layers of web material joined together. The method includes embossing a first layer of web material previously provided with a background pattern made up of a first set of protuberances so as to generate on the first layer a second set of protuberances. The second set of protuberances are partially superimposed on the first set of protuberances making up the background pattern and define an ornamental motif made up of a pattern of major dimensions and minor density with respect to the background pattern. The first layer is coupled to at least a second layer of web material by an adhesive. The adhesive is applied in areas corresponding to at least some protuberances of the second set of protuberances. The sheet material is substantially free of adhesive in correspondence with protuberances of the first set of protuberances forming the background pattern.

In asserting obviousness of the claimed invention, the Examiner relies on the teachings of Schulz '248 and Schulz '162. Applicant respectfully submits that Schulz '248 and Schulz '162, alone and in combination, fail to teach the claimed invention.

More specifically, Schulz '248 teaches an embossing and laminating apparatus for paper requiring the

supply of a first ply of web material to a first nip between a pair of pre-embossing rolls and a second ply of web material to a second nip between a second set of pre-embossing rolls. The pre-embossed plies of web materials are then joined in a third nip which is between a third pair of rolls where the plies are joined into a multi-ply web. To facilitate bonding of the plies of web material at the third nip, an adhesive is applied to the first ply by an adhesive bonding device after the first ply passes between the first pair of pre-embossing rolls but before it enters the third nip. Accordingly, the adhesive is applied to protuberances provided in the first ply of web material by the first pair of pre-embossing rolls. Thus, the adhesive can not be applied on the protrusions provided by passage through the third nip since in the third nip where the main embossing takes place, the two plies are also joined together. Accordingly, either no adhesive is applied to join the plies of web material, or the plies of web material are joined by the adhesive applied on the pre-embossed pattern provided by the first pair of embossing rolls. As such, Schulz '248 does not teach the application of an adhesive on selected protuberances of the embossed web, but only the application of adhesive on the whole pre-embossed pattern.

Schulz '162 teaches a multi-ply fibrous sheet structure and its method of manufacture. Specifically, Schulz '162 teaches a method of avoiding the problem of

having too much glue applied on a roll of material by embossing the material with protrusions having two different heights and applying glue to protrusions having the greater depth.

Applicant respectfully submits that the teaching of Schulz '162 is different from and not combinable with the teaching of Schulz '248. The teachings of Schulz '248 and Schulz '162 are not compatible in that each one excludes the other. The Examiner states that it would have been obvious to one of ordinary skill in the art at the time of the invention to perform the method of embossing and joining layers as shown in Schulz '248 by applying glue only to the second set of protuberances in order to provide improved characteristics to the web as shown by a Schulz '162. However, this is not possible since Schulz '248 can not be modified as suggested. Even though Schulz '248 states that an adhesive can be applied in a manner known in the art, the manner relied upon by the Examiner is inconsistent with the teachings of Schulz '248 when taken as a whole as required in applying §103. Thus, one skilled in the art, starting from Schulz '248 and facing the problem of reducing the amount of glue applied, would not have considered Schulz '162 as suitable for combination therewith since one skilled in the art would recognize that the teaching of Schulz '162 requires that (1) the two embossing patterns must be produced at the same time in the same embossing

process, and (2) the glue must be applied on the deeper protuberances, and therefore, these protuberances must be provided by embossment before applying glue. Schulz '248 cannot be modified to accommodate these requirements without changing a fundamental teaching therein. Thus, one skilled in the art looking for a solution to the problem of reducing the amount of glue on the web would not combine the teachings of Schulz '248 and Schulz '162 as asserted by the Examiner.

Accordingly, there is no teaching or suggestion, when the teachings of each of the combined references are taken as a whole, for modifying the teachings of Schulz '248 and Schulz '162 in order to achieve the claimed invention. Withdrawal of the §103 rejection is respectfully requested.

As to the rejections of claims 4, 11 and 12, applicant submits that since these are dependent claims, that the above with regard to Schulz '248 and Schulz '162 is also applicable thereto. The secondary references (applied with respect to limitations in the dependent claims) applied in combination with Schulz '248 and Schulz '162 with respect to claims 4, 11 and 12 do not make up for the shortcomings of the primary references with regard to the invention as claimed. Accordingly, withdrawal of the §103 rejections as to claims 4, 11 and 12 is also requested.

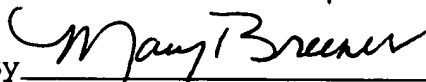
Reconsideration and allowance of the claims are respectfully urged.



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Respectfully submitted,

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